

REMARKS

Summary of the Amendment

Upon entry of the above amendment, claims 26 and 27 will have been canceled and claims 1, 16 and 29 will have been amended. Accordingly, claims 1-7, 9, 10, 12-25 and 28-30 will be pending with claims 1, 14, 16, and 29 being in independent form.

Summary of the Official Action

In the instant Office Action, the Examiner rejected claims 1-7, 9, 10, 12, 16-25, 28 and 29 over the art of record. Finally, the Examiner indicated that claims 14 and 15 were allowed and that claims 13, 26, 27 and 30 contain allowable subject matter and would be allowed if presented in independent form. By the present amendment and remarks, Applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Present Amendment is proper for entry

Applicant respectfully submits that the instant amendment is proper for entry after final rejection. Applicant notes that no question of new matter is presented nor are any new issues raised in entering the instant amendment of the claims and that no new search would be required. Moreover, Applicant submits that the instant amendment at least places the application in condition for allowance, or at least in better form for appeal. Accordingly, Applicant requests the Examiner to enter the instant amendment, consider the

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merits of the same, and indicate the allowability of the present application, and each of the pending claims.

Applicant notes, in particular, the claims have been amended in an effort to resolve the prior art rejections. Moreover, the amendment to claim 16 at least renders places claims 16-25 and 28 in condition for allowance.

Interview of January 26, 2006

Applicant appreciates the courtesy extended by the Examiner in the Interview of January 26, 2006.

In the interview, Applicant's representative pointed out that the pending claims define over the applied art of record. The Examiner disagreed and indicated that certain figures of WO 89/04727 show the combination of features recited in the rejected independent claims.

Applicant's representative then proposed amending claim 16 to recite the features of claims 26 and 27 in the alternative. In response, the Examiner acknowledged that claims 26 and 27 have been indicated to contain allowable subject matter and indicated that such an amendment would render claims 16-28 allowable.

Applicant's representative also proposed amending claims 1 and 29 to recite one or more of the features shown in Applicant's Fig. 2 and that such features were not disclosed or suggested in the applied art of record. In response, the Examiner indicated that such an amendment might raise new issues and would likely require further search and consideration.

Traversal of Rejection Under 35 U.S.C. § 102(b)

Applicant traverses the rejection of claims 1, 2, 4-6, 9, 10, 12, 16, 17, 20-25 and 29 under 35 U.S.C. § 102(b) as being anticipated by WO 89/04727.

The Examiner asserted that this document discloses or suggests all the features recited in these claims including the glue nozzle and the device. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what this document discloses, Applicant submits that this document fails to disclose, or even suggest: inter alia, a glue nozzle coupled to glue reservoir, the glue nozzle comprising a tip having an outlet opening arranged to apply glue to the moving web while the moving web moves along a direction, a device that delivers a substance to a region of the outlet opening, the device comprising a tube whose tip is *angled to correspond to a tapered portion of the tip of the glue nozzle, whereby the tip of the tube is arranged adjacent the tip of the glue nozzle, wherein a free end of the tip of tube is positioned approximately generally level with the free end of the tip of the glue nozzle*, as recited in amended independent claim 1; and inter alia, a glue nozzle comprising a tip having an outlet opening, the glue nozzle being adapted to apply glue through the outlet opening, a feeding device that delivers a substance to a region of the outlet opening, the feeding device being a tube separate from the glue nozzle and whose tip is arranged adjacent the tip of the glue nozzle, *the tip of the tube being angled to correspond to a tapered portion of the tip of the glue nozzle*, and a free end of the tip of the tube being positioned *approximately generally level with a free end of the tip of the glue*

nozzle, as recited in amended independent claim 29.

With regard to claims 16, 17, 20-25, Applicant submits that the rejection of these claims is moot inasmuch as claim 16 has been amended to include features which have been indicated by the Examiner to define over the art of record.

With regard to the remaining claims, Applicant acknowledges that WO 89/04727 discloses various embodiments of a coating nozzle which utilizes a device for feeding a substance to the coating. Applicant also acknowledges that Fig. 7 appears to show the device delivers the substance behind the outlet opening relative to the direction. Applicant also acknowledges that Fig. 14 shows a device 77 whose tip 77M is arranged adjacent the nozzle 68. However, Applicant submits that WO 89/04727 clearly does not disclose, or even suggest, that the device comprises a tube whose tip is angled to correspond to a tapered portion of the tip of the glue nozzle, whereby the tip of the tube is arranged adjacent the tip of the glue nozzle, much less, that a free end of the tip of tube is positioned approximately generally level with the free end of the tip of the glue nozzle. To the contrary, Fig. 14 shows the tip 77M set back from the tip 68M of the nozzle 68.

Moreover, as WO 89/04727 appears to be limited to a nozzle for applying a coating, Applicant submits that this document cannot properly be read to disclose or suggest a method of applying glue to a moving web, much less, one which utilizing a system that includes a glue nozzle coupled to glue reservoir, the glue nozzle comprising a tip having an outlet opening arranged to apply glue to the moving web, and a device that delivers a substance to a region of the outlet opening, wherein the device is a tube whose tip is arranged adjacent the tip of the glue nozzle.

Thus, it is clear that WO 89/04727 fails to disclose or even suggest the combination of features recited in at least independent claims 1 and 29.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102 to be proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Moreover, Applicant submits that dependent claims 2 and 4-6, 9, 10 and 12 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of WO 89/04727 discloses or suggests, in combination: that the moving web comprises one of a cigarette paper web in strip form and folding box blanks as recited in claim 2; that the substance comprises at least one of a substance adapted to liquefy the glue, a low-viscosity fluid, water, and water vapor as recited in claim 4; that the device delivers the substance directly behind the outlet opening relative to the direction as recited in claim 5; that the device is adapted to deliver the substance in the form of spots as recited in claim 6; that the device is arranged at a distance "d" from the glue nozzle as recited in claim 9; that the device is one of arranged directly adjacent to the glue nozzle and arranged to abut the glue nozzle as recited in claim 10; and that the system further comprises a system for feeding the substance to the device as recited in claim 12.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(b).

Traversal of Rejections Under 35 U.S.C. § 103(a)

Over WO 89/04727 alone

Applicant respectfully traverses the rejection of claims 7, 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over WO 89/04727 alone.

The Examiner acknowledged that WO 89/04727 lacks, among other things, the features recited in the above-noted claims such as the recited liquefied of the glue after the glue is applied. However, the Examiner asserted that such features would have been obvious to one of ordinary skill in the art. Applicant respectfully traverses this rejection.

With regard to claims 18 and 19, Applicant submits that the rejection of these claims is moot inasmuch as claim 16 has been amended to include features which have been indicated by the Examiner to define over the art of record.

Furthermore, notwithstanding the Examiner's assertions as to what WO 89/04727 discloses or suggests, Applicant submits that in addition to failing to anticipate the invention recited in amended independent claim 1, WO 89/04727 also fails to teach or suggest the invention recited in at least dependent claim 7.

Applicant directs the Examiner's attention to the guidelines identified in M.P.E.P. section 2141 which state that "[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates, "[o]bviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Moreover, it has been legally established that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references)."

Additionally, it has been held that "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

Moreover, Applicant submits that there is no motivation to modify WO 89/04727 in a

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manner which would render obvious Applicant's invention, and additionally, Applicant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference in the manner suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify this document in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied reference.

Furthermore, Applicant submits that dependent claim 7 is allowable at least for the reason that these claims depend from an allowable base claim and because this claim recites additional features that further define the present invention. In particular, Applicant submits that no proper reading or modification of WO 89/04727 discloses or suggests, in combination: that the tube is a capillary as recited in claim 7.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 103(a).

Over WO 89/04727 and Fietkau

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over WO 89/04727 in view of US published patent application 2002/0023655 to FIETKAU.

While acknowledging that WO 89/04727 lacks, among other things, any disclosure with regard to the recited apparatus being arranged on a cigarette making machine, the Examiner asserts that FIETKAU teaches such a feature and that it would have been

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obvious to modify WO 89/04727 in view of FIETKAU. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what these documents disclose or suggest, Applicant submits that no proper combination of WO 89/04727 and FIETKAU discloses or suggests, inter alia, a glue nozzle coupled to glue reservoir, the glue nozzle comprising a tip having an outlet opening arranged to apply glue to the moving web while the moving web moves along a direction, a device that delivers a substance to a region of the outlet opening, the device comprising a tube whose tip is *angled to correspond to a tapered portion of the tip of the glue nozzle, whereby the tip of the tube is arranged adjacent the tip of the glue nozzle, wherein a free end of the tip of tube is positioned approximately generally level with the free end of the tip of the glue nozzle*, as recited in amended independent claim 1.

As explained above, WO 89/04727 fails to disclose or suggest that the device comprises a tube whose tip is angled to correspond to a tapered portion of the tip of the glue nozzle, whereby the tip of the tube is arranged adjacent the tip of the glue nozzle, much less, that a free end of the tip of tube is positioned approximately generally level with the free end of the tip of the glue nozzle. To the contrary, Fig. 14 shows the tip 77M set back from the tip 68M of the nozzle 68.

Furthermore, Applicant does not dispute that FIETKAU discloses a glue nozzle having a glue opening 52 and openings that allow for the passage of pressurized air (see Fig. 5 and paragraphs [0045] and [0048]). However, it is apparent from a fair reading of FIETKAU that this document lacks any disclosure or suggestion with regard to the device

being a tube whose tip is arranged adjacent the tip of the glue nozzle. Indeed, it is clear from Fig. 5 of FIETKAU that the device is not separate from the glue nozzle. Finally, it is clear that FIETKAU does not disclose or suggest that the device comprises a tube whose tip is angled to correspond to a tapered portion of the tip of the glue nozzle, whereby the tip of the tube is arranged adjacent the tip of the glue nozzle, much less, that a free end of the tip of tube is positioned approximately generally level with the free end of the tip of the glue nozzle.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least amended independent claim 1. Because both applied documents fail to disclose or suggest at least the above-noted features of the instant invention, Applicant submits that no proper combination or modification of these documents can render unpatentable the combination of features recited in at least independent claim 1.

Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify WO 89/04727 in view of FIETKAU in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of these disclosures.

Furthermore, Applicant submits that dependent claim 3 is allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant

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submits that no proper combination of WO 89/04727 and FIETKAU discloses or suggests, in combination: that the system is arranged on one of a continuous cigarette making machine and a cigarette packing machine as recited in claim 3.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that this claim is allowable over the applied art of record.

Over WO 89/04727 with Yapel

Applicant respectfully traverses the rejection of claim 28 under 35 U.S.C. § 103(a) as unpatentable over WO 89/04727 in view of US Patent No. 6,117,237 to YAPEL et al.

The Examiner acknowledged that WO 89/04727 lacks, among other things, the features recited in the above-noted claim. However, the Examiner asserted that such features are taught in YAPEL and that it would have been obvious to one of ordinary skill in the art to combine the teachings of these documents. Applicant respectfully traverses this rejection.

Applicant submits that the rejection of this claim is moot inasmuch as claim 16 has been amended to include features which have been indicated by the Examiner to define over the art of record and because claim 28 depends from claim 16.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claim under 35 U.S.C. § 103(a).

Acknowledgment of Allowable Subject Matter

Applicant acknowledges and appreciates the Examiner's indication that claims 14 and 15 are allowed and that claims 13, 26, 27 and 30 contain allowable subject matter and would be allowable if presented in independent form. However, at this time, Applicant is not presenting these claims in independent form.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to refund excess payments and charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

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Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
D. JANZ et al.

A handwritten signature in black ink, appearing to read 'Neil F. Greenblum', written over a horizontal dashed line.

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